Question Q217

National Group: **AIPPI Austria**

Title: **The patentability criterion of inventive step / non-obviousness**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

   In Section 1 of the Austrian Patent Act it is stated that a patentable invention must not be obvious from prior art for a person skilled in the art. The person skilled in the art is presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date (average skilled person). To consider whether non-obviousness is given the Austrian Patent Office usually follows the "problem-solution approach" of the European Patent Office, including the "could-would-test" as examination scheme.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

   The major change was already more than 20 years ago, in 1984, when the requirement of non-obviousness was implemented into the Austrian Patent Act, although before 1984 the requirement of non-obviousness was already established by case law. After 1984, case law successively developed further and in more detail the standard for non-obviousness, usually following the developments in the case law of the European Patent Office.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

The Austrian Patent Office has published examination guidelines. But, in contrast to the examination guidelines of the European Patent Office, they only refer in a marginal way to non-obviousness and are therefore not or only minor useful and effective with regard to non-obviousness.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

   No.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

   The Austrian Patent Act refers in its Section 22a to the Protocol on the Interpretation of Art 69 EPC. Thus, patent claims may not be interpreted as defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties. The claims are read as would be understood by a person skilled in the art.

6. Is it possible to read embodiments from the body of the specification into the claims?

   The Austrian Supreme Patent and Trademark Chamber [Oberster Patent- und Markensenat (OPM)] ruled that if a claim is formulated ambiguously, and the specification provides for different embodiments which fall under the scope of the ambiguous wording the embodiments can be read into the claim (OPM 9.11.1994, PBl 1996, 11). But in any case, the scope of protection is limited by the content of the claims and may not be extended further.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

   In Austria, prior art is interpreted as would be understood by a person skilled in the art. Prior publications are understood in a way that they disclose only what can be learned from them in an explicit manner. But if a certain feature implies by nature a certain element this element may be seen as disclosed too.

8. Do the answers to any of the questions above differ during examination versus during litigation?

   No.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

   It is proper to find lack of inventive step or obviousness over a single prior art reference in case of a combination of different embodiments in a single prior art reference or also in case of a combination of a single prior art reference with common general knowledge, as available for a person skilled in the art. In the latter case, in order to provide the missing teaching(s), the level of the common general knowledge is an issue to be considered.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

    It has to be examined whether it was obvious for a person skilled in the art to combine the respective prior art references. To consider whether this is the case the Austrian Patent Office usually follows the "problem-solution approach" of the European Patent Office, including the "could-would-test" as examination scheme.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

    It has to be determined whether it is obvious for a person skilled in the art to link a solution in one technical field to the other technical field to get a solution for the same problem. The closer the technical fields are, the higher is the probability that the linkage of a solution may be seen as obvious. Furthermore, it is of big relevance which problem the inventor of the claim in question was trying to solve. If a solution in one technical field is to be seen in another technical field as solution for another problem, this may indicate non-obviousness.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

    Yes, it is permitted to combine more than two references to show lack of inventive step or obviousness. But usually if the combination of two prior art references does not show lack of inventive step or obviousness this may indicate inventiveness.

    If combined features of the subject matter of application, respectively, each only provide a solution for a separate problem and if these features do not interact in a synergistic way to solve a joint problem of the invention, separate prior art for each feature may serve as a basis for arguing obviousness. Thereby, a combination of more than two references would be allowed.

13. Do the answers to any of the questions above differ during examination versus during litigation?

    No.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

    The technical problem plays an important role, in particular when applying the problem-solution approach.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

    As the technical problem can change during the grant procedure due to state of the art found during the search, the technical problem can be adapted to the new circumstances and as such does not have to be in the specification as filed.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

    An advantageous effect is usually considered as a subsidiary criteria for determining inventive step.

17. Must the advantageous effects be disclosed in the as-filed specification?

    No, the advantageous effect does not need to be disclosed per se, but the practitioner in the field must be able to at least derive the effect implicitly from the disclosure or the effect has to be related to an effect disclosed in the description as filed. (EPO, T184/82 Abl. 6/1984, 261).

18. Is it possible to have later-submitted data considered by the Examiner?

    Yes.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

    Yes. Paper examples are sufficient.

20. Do the answers to any of the questions above differ during examination versus during litigation?

    No.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

    Yes. The teaching away must not be explicit.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

    Teaching away is considered to be an important factor.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

Examples for secondary considerations are: predictable disadvantages, unexpected technical effects or additional- or bonus-effects and/or that it fulfils a long-term need. Secondary considerations do not necessarily have to stem from the initially filed description but can be furnished later during the procedure. Secondary considerations have to be proven, but this can be done via argumentation, if sound. A close connection with the claimed invention is helpful.

26. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?
If yes, please describe these issues, tests, or factors.

No.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

n/a

29. Does such test differ during examination versus during litigation?

n/a

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

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31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

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Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

No.

33. If yes, is this problematic?

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Yes. Especially if plans to implement a European Patent Litigation System may be successful it would be advantageous to have harmonized rules in regard to the criteria of inventive step / non-obviousness.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

We think that the EPO approach on inventive step / non-obviousness should be a good basis for a universally acceptable standard.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

We would suggest the following: A *patentable invention must not be obvious from prior art for a person skilled in the art. The person skilled in the art shall be presumed as an ordinary practitioner aware of what was common general knowledge in the art at the relevant date (average skilled person).*

Furthermore, we would consider the EPO approach / problem – solution approach as broadly acceptable.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

To consider whether non-obviousness is given we suggest following the "problem-solution approach" of the European Patent Office, including the "could-would-test" as examination scheme.

Summary:
To consider non-obviousness the Austrian Patent Office usually follows the "problem-solution approach" of the European Patent Office, including the "could-would-test" as examination scheme. No other tests are taken into consideration in determining inventive step. Prior art is interpreted as would be understood by a person skilled in the art.

It is permitted to combine more than two references to show lack of inventive step. But usually if the combination of two prior art references does not show lack of inventive step or obviousness this may indicate inventiveness. Secondary considerations are recognized. Teaching away is recognized as a factor in favor of inventive step.

The assessment of inventive step does not differ during examination versus during litigation or invalidity proceedings.

Zusammenfassung:
Bei der Beurteilung der erfinderischen Tätigkeit geht das österreichische Patentamt im Allgemeinen nach dem Aufgabe-Lösungs-Ansatz vor, wobei weiters der "Could-Would-Test" angewendet wird. Andere formalisierte Tests kommen nicht zur Anwendung. Der Stand der Technik wird so interpretiert, wie er vom Durchschnittsfachmann verstanden werden würde.

Es ist zulässig mehr als zwei Entgegenhaltungen miteinaner zu kombinieren, um das Fehlen einer erfinderischen Tätigkeit zu zeigen. Allerdings kann die Heranziehung von mehr als zwei Entgegenhaltungen auf das Vorliegen einer erfinderischen Tätigkeit hindeuten. Beweisanzeichen werden anerkannt. Der Umstand, dass eine Entgegenhaltung von der Erfindung wegweist, wird ebenfalls anerkannt.

Die Beurteilung der erfinderischen Tätigkeit im Prüfungsverfahrens weicht nicht grundsätzlich von der Beurteilung im Verletzungs- oder Nichtigkeitsverfahren ab.

Résumé:
Pour juger l'activité inventive l'Office autrichien des brevets suit habituellement l' "approche problème-solution" de l'Office européen des brevets, y compris l' approche could-would comme système d'examen. Pas d'autres tests sont pris en considération dans la détermination de l'activité inventive. L'art antérieur est interprété comme serait comprise par l'homme du métier.

Il est permis de combiner plus de deux références pour montrer l'absence d'activité inventive. Mais généralement, si la combinaison de deux références de létat de la techniqu ne montre pas le manque d'activité inventive ou l'évidence, cela peut indiquer inventivité. Considérations secondaires sont reconnus. Enseigner l'écart est reconnue comme un facteur en faveur de l'activité inventive.

L'évaluation de l'activité inventive ne diffère pas lors de l'examen par rapport au cours de procédures contentieuses ou d'invalidité.